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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,057	12/13/2000	Marjorie C. Ravitz	15173.200	6585
27383	7590	10/05/2004	EXAMINER	
CLIFFORD CHANCE US LLP 31 WEST 52ND STREET NEW YORK, NY 10019-6131			PICKETT, JOHN G	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/736,057

Applicant(s)

RAVITZ ET AL.

Examiner

Gregory Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 15 June 2004 has been entered. Claims 1-31 are pending in the application.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 112***

3. In light of the applicant's amendment, the rejection of claims 30 and 31 under 35 U.S.C. 112, second paragraph, are hereby withdrawn.

### ***Claim Rejections - 35 USC § 102***

4. Claims 1-5, 7, 10, 12-13, 15-16, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Potter (US 5,714,098).

Regarding claim 1, Potter discloses a foot wear fitting method (Figure 11) comprising the steps of maintaining an inventory of shoes (63) at appoint of sale

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location (see Figure 1), measuring the size and width (55) and arch height (Col. 5, lines 34-37), selecting the proper size (63), and fitting the shoe to the customer (75).

On page 15, lines 5-9 of the specification of the present application, applicant defines the flat inner foot receiving surface as having all arch support or otherwise normally provided cushioning removed. Potter anticipates inserting an orthotic onto the flat inner foot-receiving surface of the shoe (Col. 9, lines 26-41). The examiner interprets the term insert, used by Potter, to be orthotics.

As to claims 2-3, Potter anticipates an inventory of prefabricated orthotics (Col. 9, lines 34-36).

As to claims 4-5, Potter anticipates a custom made orthotic fabricated from the size, width, and arch height for each foot (Col. 9, lines 42-50).

As to claim 7, Potter anticipates a variety of shoe types, including dress shoes (Col. 5, lines 41-46).

As to claims 12-13, Potter anticipates a system having an inventory of shoes (step 63), sample insoles are a device for measuring the size, width and arch height (Col. 9, lines 42-44), an inventory of prefabricated orthotics having a range of sizes and arch heights (Col. 9, lines 26-41), and fitting the combination on the customer (step 75).

As to claims 15-16, Potter anticipates a system having an inventory of shoes (step 63) at point of sale location (see Figure 1), sample insoles are a device for measuring the size, width and arch height (Col. 9, lines 42-44), custom made orthotics fabricated from the measurements of the size, width, and arch heights (Col. 9, lines 42-50), and fitting the combination on the customer (step 75).

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As to claim 18, Potter anticipates a variety of shoe types, including dress shoes (Col. 5, lines 41-46).

***Claim Rejections - 35 USC § 103***

5. Claims 6, 8-11, 17, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Potter.

Regarding claims 6 and 17, Potter discloses a method and system as applied to claims 1 and 15 above. Potter does not disclose an orthotic, which is a prescription orthotic.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use prescription orthotics in the method and system of Potter in order to offset the price of the shoe to the customer through insurance coverage available through a prescription orthotic.

As to claims 8-9 and 19-20, Potter discloses a method and system as applied to claims 1 and 15 above. Potter does not expressly disclose women's fashion shoes.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make women's fashion shoes available to the method and system of Potter in order to supply a greater choice to female customer's.

As to claim 10, Potter discloses the claimed invention except for measuring one of only three foot widths. Potter teaches the use of finer width increments to increase the quality of fit for the wearer, thereby indicating that width increments are proportional to fit quality (see Col. 1, lines 35-62). By its inverse, if fit quality is not of concern,

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reduction of width increments can be obtained. It would have been obvious to one of ordinary skill in the art at the time the invention was made to reduce the width increments of Potter to limit tooling and equipment costs. Further, it has been held that omission of an element and its function in a combination where the remaining elements perform the same function involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

As to claim 11, Potter discloses a method as applied to claim 1 above. Potter does not disclose the selection of the shoe style over the Internet.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide shoe selection options over the Internet to the method of Potter in order to reduce inventory requirements at the retail store.

6. Claims 14 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Potter as applied to claims 12 and 15 above, and further in view of Yates (GB 2 115 164 A).

Regarding claims 14 and 21, Potter discloses a system as applied to claims 12 and 15 above. Potter does not disclose a device for measuring width that includes indicia for measuring only one of three foot widths.

Yates discloses a width measuring device that provides for only three width zones (half size larger, size indicated, and ask sales assistant)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the Yates device in the system of Potter in order to pre-size

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the customer's foot and reduce the number of sample insoles required to be tried by the customer, thereby expediting the sizing process.

7. Claims 22-24, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pietzuch (US 1,324,267) in view of Scholl (US 2,480,776).

Regarding claim 22, Pietzuch discloses a device (21) with a surface for receiving a foot (20), a first reference (28), a second reference (26), a third reference (27), a first indicia (23), and a second and third indicia (24, 25).

Pietzuch does not disclose a first and second mechanism for measuring the height of the arch of the foot.

Scholl discloses a mechanism (22, 24, 27, 28) for measuring the height of the arch of the foot. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the device of Pietzuch with a mechanism as taught by Scholl in order to measure the height of the arch of a foot and customize a shoe accordingly (see for example, Scholl, Col. 1, ll. 15-19). It would have further been obvious to provide two devices in order to maintain the symmetry of the Pietzuch device.

As to claim 23, the device of Pietzuch-Scholl discloses the claimed invention except for only three lines for width measurement. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the device of Pietzuch-Scholl with only three lines since it has been held that omission of an element

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and its function in a combination where the remaining elements perform the same function involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

As to claim 24, the device of Pietzuch-Scholl discloses a first and second mechanism comprising a wedge (Scholl, 22) movable longitudinally towards and away from the arch of a foot by means of a slot (25). The device of Pietzuch-Scholl would have anticipated indicia (see for example, Scholl, Col. 2, ll. 42-47).

As to claim 30, the device of Pietzuch-Scholl discloses parallel width lines (Pietzuch, Figure 1).

8. Claims 25-26, 28-29, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rolloff et al. (US 5,640,779) in view of Legg Jr. (US 2,518,798).

Regarding claim 25, Rolloff et al. discloses a device 10 for measuring foot size with housing 14, first reference 52, second reference 54, third reference 56, and scanners 108. The device of Rolloff et al is capable of use in a centerline reference manner and it would have been obvious to one of ordinary skill in the art at the time the invention was made to use it in such a manner in order to account for variations on the outside of the user's foot.

Rolloff et al. does not expressly disclose first, second, and third indicia.

Legg Jr. discloses a device for measuring a foot with indicia as claimed by the applicant. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Rolloff et al. with indicia as taught by Legg Jr. and claimed by the applicant in order to visually verify the measurements taken by



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the device and further to quickly determine shoe sizing for reception of the completed orthotic.

As to claim 26, the device of Rolloff-Legg discloses the claimed invention except for only three lines for width measurement. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the device of Rolloff-Legg with only three lines since it has been held that omission of an element and its function in a combination where the remaining elements perform the same function involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

As to claim 28, the device of Rolloff-Legg discloses a processor (Rolloff, 162).

As to claim 29, the device of Rolloff-Legg discloses a modeler (Rolloff, 216).

As to claim 31, the device of Rolloff-Legg discloses parallel width lines (Legg Jr., 26, 27).

9. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rolloff et al. in view of Legg Jr. as applied to claim 25 above, and further in view of White (US 5,237,520).

Rolloff-Legg discloses a device as mentioned and modified above. Rolloff-Legg does not disclose scanners comprising CCD imagers.

White discloses a foot sizing device with laser-optic scanners (Col. 5, lines 45-52). Laser-optic scanners use a CCD array.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Rolloff-Legg with CCD imagers as taught by

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White in order to reduce the number of moving parts necessary for the device to function.

### ***Response to Arguments***

10. Applicant's arguments filed 15 June 2004 have been fully considered but they are not persuasive.

11. The examiner respectfully disagrees with the applicant's assertion that Potter does not disclose a point of sale location. This feature is clearly shown in Figure 1 of Potter. The argument concerning the flat inner surface was addressed in section 10 of the Final Rejection and the examiner maintains the position.

12. In response to applicant's argument that the provision of a right and left mechanism to Scholl would render Scholl inoperable, the examiner notes that it is Pietzuch that is modified by the teachings of Scholl. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

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13. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

14. In response to applicant's argument that there is no suggestion to modify the Rolloff reference, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation can be found in the knowledge generally available to one of ordinary skill in the art, where it was commonly known that the outer portions of some feet vary.

15. In response to the applicant's argument that neither Rolloff et al nor Legg Jr. discloses scanner to scan an image of the foot in three dimensions, Rolloff discloses

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scanners 108 for scanning an image of the foot in three dimensions, length, width, and height (see Figure 3).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 703-305-8321. The examiner can normally be reached on Mon-Fri, 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Greg Pickett  
Examiner  
22 September 2004

  
Mickey Yu  
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Group 3700